

1 The opinion in support of the decision being entered today
2 was not written for publication
3 and is not binding precedent of the Board
4

5 UNITED STATES PATENT AND TRADEMARK OFFICE
6

7
8 BEFORE THE BOARD OF PATENT APPEALS
9 AND INTERFERENCES
10

11
12 *Ex parte* JOSEPH ORESTE CARNALI and YAN ZHOU
13

14
15 Appeal 2006-3000
16 Application 09/758,685¹
17 Technology Center 1700
18

19
20 Oral Argument: None
21 Decided: September 26, 2006
22

23
24 *Before: McKELVEY, Senior Administrative Patent Judge, and SCHAFER*
25 *and TORCZON, Administrative Patent Judges.*
26

27 *McKELVEY, Senior Administrative Patent Judge.*
28

29 **DECISION ON APPEAL UNDER 35 U.S.C. § 134**
30

31 **A. Introduction**

32 The appeal is from a decision of the Primary Examiner rejecting
33 claims 1-12 on appeal as being anticipated under 35 U.S.C. § 102(b) over
34 European Patent Application 0 851 022 A2, published 01 July 1998.

35 We affirm.

¹ Application filed 11 January 2001. The real party in interest is Unilever Home & Personal Care USA, Division of Conopco, Inc.

1 wherein said polymer is released into a cold, penultimate rinse
2 cycle preceding a heated, final rinse cycle of a dishwashing
3 sequence;

4
5 wherein said vehicle of (B) is defined as (1) the sum of all
6 components forming said composition except for said
7 antiscaling polymer; or (2) an encapsulating material or other
8 slow release protective chemical or device.

9
10 The claim is peculiar in that it is directed to a "composition" and yet it
11 requires that a specific method step be performed, *viz.*, "wherein said
12 polymer is released into a cold, penultimate rinse cycle preceding a heated,
13 final rinse cycle of a dishwashing sequence." The method step in no way
14 defines the "composition." We have treated the method step as defining a
15 "property" of the composition, or as the Examiner indicated (Examiner's
16 Answer, page 6), as a statement of intended use, *i.e.*, that the composition
17 must be capable of being used in the manner otherwise set out in the method
18 step. In the event of further prosecution, attention is directed to *IPXL*
19 *Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1384, 77 USPQ2d
20 1140, 1145 (Fed. Cir. 2005) (single claim covering both an apparatus and a
21 method of use of that apparatus held to be indefinite under the second
22 paragraph of 35 U.S.C. § 112); *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat.
23 App. & Int. 1990) (same). Claims 1-11 are indefinite, but we have
24 proceeded with the appeal giving those claims the construction we believe
25 applicants intended. *Cf. Stelos Co., Inc. v. Hosiery Motormend Corp.*,
26 295 U.S. 237, 243 (1935).

1 Claim 12

2 A method for washing soiled dishes comprising charging a
3 mechanical dishwashing composition to a wash liquor in a washing
4 machine, the composition comprising [a composition defined essentially the
5 same as the composition of claim 1]

6 wherein said method comprises charging said dishwashing
7 composition to a cold, penultimate rinse cycle preceded by a
8 heated, final rinse cycle of a dishwashing sequence.

9
10 **D. Discussion**

11 We are told in the specification under a heading styled "The Related
12 Art," which we take to mean the prior art, that "[t]he machine dishwashing
13 process comprises washing articles in a main wash cycle and rinsing them
14 in one or more rinse cycles." Specification, page 1, ¶ 0002, lines 1-2.
15 Generally the wash program of a machine dishwasher involves a sequence of
16 water fill, wash/rinse and water drain cycles which are automatically
17 performed by the machine without operator intervention. Specification,
18 page 5, ¶ 00013, lines 1-3. Applicants' description of the prior art is
19 consistent with our experience with dishwashers. What applicants
20 apparently believe is novel is the use of the anti-scaling polymer and vehicle
21 in what applicants call a penultimate rinse and preferably both the
22 penultimate rinse and a final rinse cycle. Specification, page 5, ¶ 00013,
23 lines 3-8. The invention "contrasts with [what is said to be the] historic
24 practice in this art of dosing scale inhibitors via rinse cycle compositions
25 added only to the final rinse cycle." Specification, page 5, ¶ 00013,
26 lines 8-10. Applicants go on to say that "[i]t is not generally appreciated that
27 any component of the role of a rinse cycle composition can be efficiently

1 performed from other than the final rinse cycle." Specification, page 5,
2 ¶ 00013, lines 10-12.

3 Composition claims 1-11 stand or fall together. Claim 12 is argued
4 separately. Brief for Appellants, page 11 (filed 15 March 2004).

5 The Primary Examiner rejected claims 1-12 as being anticipated under
6 35 U.S.C. § 102(b) over European Patent Application 0 852 022 A2,
7 published 01 July 1998.

8 The European Patent Application (EPA) names applicants as
9 inventors. Applicants in the Brief for Appellants do not argue that the
10 European Patent Application fails to describe applicants' composition. In
11 particular, applicants do not tell us why or how the Primary Examiner is
12 supposed to have erred in rejecting composition claims 1-11. 37 CFR
13 § 41.67(c)(1)(vii) (a brief must contains the contentions with respect to each
14 issue). Accordingly, there is no basis for reversing the decision to reject
15 those claims.

16 With respect to method claim 12, it is argued that the Primary
17 Examiner erroneously found that EPA describes a process of using the
18 composition in all phases of a rinse cycle. Brief for Appellants, page 12.
19 We are told that the Primary Examiner's "reading of the art is simply
20 strained ..." *Id.* Also, the Primary Examiner is said to have overlooked
21 clear advantages of using the composition in the penultimate rinse stage as
22 opposed to a final rinse stage. *Id.* EPA is said to talk "only of a final rinse
23 step (singular not plural)." *Id.* Without explaining why, applicants maintain
24 that they "have provided a showing that the stage of introduction does make
25 a difference" and that the Primary Examiner's rejection is based on
26 "hindsight." *Id.* We proceed to an analysis of EPA based on the arguments
27 which are presented on a single page of the Brief for Appellant (page 12).

1 According to EPA, "[t]he machine dishwashing process comprises
2 washing articles in a main wash cycle and *rinsing them in one or more rinse*
3 *cycles.*" (Emphasis added). Page 1, lines 10-11. EPA goes on to say "[a]
4 rinse aid composition is designed for use in the final rinse step of the
5 machine dishwashing operation, separately from the detergent composition
6 used in the main wash cycle." Page 1, lines 11-12. Based on the last
7 sentence, in this appeal applicants seemingly attempt to limit the description
8 of the use of the compositions of EPA to only a final rinse. Use of the
9 composition in the final rinse is more likely a preferred embodiment of EPA.
10 Inconsistent with applicants' current argument is their "pre-litigation" EPA
11 statement that "[t]he invention is also directed to a method of using the
12 polymers in machine dishwashing ..." (page 2, lines 14-15) and claim 10.
13 EPA claim 10 describes "[a] method of rinsing tableware in a machine
14 dishwasher with a rinse aid composition useful for inhibiting scale
15 comprising the steps of ... introducing the rinse aid into *a* rinse cycle of a
16 machine dishwasher to inhibit scale formation." (Emphasis added).
17 Applicants now attempt to place a narrow construction on what they
18 describe in EPA. The credible description of the prior art "one or more rinse
19 cycles" (EPA, page 1, lines 10-11) and EPA claim 10 provide a more than
20 adequate basis for finding that a person having ordinary skill in this art,
21 considering EPA as a whole, would understand that EPA describes the use
22 of the composition in any rinse cycle. We find it unlikely that a mechanical
23 dishwasher would ordinarily include more than a small number of rinse
24 cycles. A disclosure that a composition can be used in a rinse cycle is a
25 description to a person having ordinary skill of using the composition in the
26 known penultimate and final rinse cycles. *Cf. In re Petering*, 301 F.2d 676,

1 133 USPQ 275 (CCPA 1962) and *In re Schaumann*, 572 F.2d 312, 197
2 USPQ 5 (CCPA 1978).

3 Contrary to applicants' argument, the Primary Examiner's reading of
4 EPA is not strained. Instead substantial evidence supports the Primary
5 Examiner's finding that EPA describes the use of the composition in a
6 known prior art rinse cycle, including a penultimate rinse cycle. Also, the
7 Primary Examiner also did not improperly fail to accord proper weight to an
8 alleged showing that use of the composition in the penultimate step "does
9 make a difference." Whether the alleged showing is relevant or irrelevant
10 with respect to a rejection under 35 U.S.C. § 103, it is not material with
11 respect to anticipation. *Cf. In re Schaumann, supra.*

12 **E. Order**

13 Upon consideration of the record set out in Part B, and for the reasons
14 given, it is

15 ORDERED that the decision of the Primary Examiner rejecting
16 claims 1-12 is affirmed.

1 FURTHER ORDERED that the provisions of 37 CFR
2 § 1.136(a) are not applicable to time periods for taking subsequent action.

3

4

5 /ss/ Fred E. McKelvey)

6 FRED E. McKELVEY)

7 *Senior Administrative Patent Judge*)

8) BOARD OF

9 /ss/ Richard E. Schafer) PATENT

10 RICHARD E. SCHAFER) APPEALS

11 *Administrative Patent Judge*) AND

12) INTERFERENCES

13 /ss/ Richard Torczon)

14 RICHARD TORCZON)

15 *Administrative Patent Judge*)

1 cc (via First Class Mail):
2
3 Ronald A. Koatz, Esq.
4 UNILEVER INTELLECTUAL PROPERTY GROUP
5 700 Sylvan Avenue
6 Bldg C2 South
7 Englewood Cliffs, NJ 07632-3100
8
9 Tel: 201-840-2912
10 Fax: 201-894-2400
11 Email: None